IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicants: Bogrett et al

Art Unit: 1771

Serial No. 09/912,290

Filed: July 24, 2001

For: INSULATION BATT AND METHOD
OF MAKING THE BATT

Jeremy R. Pierce
Examiner

April 3, 2005

APPELLANT'S BRIEF ON APPEAL
UNDER 37 C.F.R. SECTION 1.192(a)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants hereby appeal the decision of the Examiner as set forth in the Office Action dated June 9, 2004, wherein the Examiner rendered a final rejection of claims 1-9. Appellants' are filing this new brief to comply with 37 CFR 41.37 in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed on March 9, 2005, hence, this brief, submitted in triplicate, is timely.

I. REAL PARTY IN INTEREST

Johns Manville International, Inc., having a place of business at 717 17th Street, Denver, Colorado, 80202, is the assignee of the subject patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interference proceedings, known to Appellants, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 to 18 are pending in the application. Claims 10 to 18 have been withdrawn from consideration. Appellants hereby appeal the rejection of claims 1 to 9.

IV. STATUS OF AMENDMENTS

Appellants' amendment filed on March 25, 2004 has been entered.

V. SUMMARY OF THE INVENTION

As shown in Figures 5 and 6 and described in lines 3 to 18 of page 6 of the specification, each of the resilient fibrous insulation batts 20 of the subject invention is formed by a single blanket section of the series 50 of blanket sections cut from the resilient fibrous insulation blanket 46. The resilient fibrous insulation batt 20, as shown in Figures 5 and 6, is not folded and, as described in lines 16 to 21 of page 2 and in lines 3 to 7 of page 6, is cut from the resilient fibrous insulation blanket 46 to complete the formation of the resilient fibrous

insulation batt 20. As best shown in Figure 6, the resilient fibrous insulation batt 20 of the subject invention has a length, a width and a thickness. The length of the batt 20 is a longest dimension of the batt 20; the thickness of the batt 20 is a shortest dimension of the batt 20; and the width of the batt 20 is a dimension of the batt 20 intermediate the length and the thickness of the batt in magnitude. The batt 20 has first and second major surfaces 62 that, with respect to each other, lie in substantially parallel planes and that each extend the length and width of the batt 20. The batt 20 has first and second lateral surfaces 64 that, with respect to each other, lie in substantially parallel planes, that extend for the length of the batt 20, and that extend between the major surfaces of the batt 20. The batt 20 has first and second end surfaces 66 that, with respect to each other, lie in substantially parallel planes, that extend the width of the batt, and that extend between the major surfaces 62 of the batt. The fibers of the batt 20 are randomly oriented and entangled together and predominately lie in planes 70 that extend substantially perpendicular to the planes of the major surfaces 62 and the end surfaces 66 of the batt 20 and substantially parallel to the planes of the lateral surfaces 64 of the batt 20 to facilitate a widthwise compression of the batt 20.

VI. ISSUES

Claims 1 to 9 have been rejected under 35 U.S.C. Section 112, first paragraph, as failing to comply with the written description requirement. The rejection states that "The claim(s) contains subject matter which is not described in the specification is such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, has possession of the claimed invention.

Claims 1, 2, 4, and 5 have been rejected under 35 U.S.C. Section 102(b) as being anticipated by the international application of Brandt et al, International Publication Number WO

94/16162, published July 21, 1994 (hereinafter, Brandt et al; copy enclosed).

Claims 3 and 6 to 9 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Brandt et al in view of Michelsen, U.S. Patent No. 5,765,318, issued June 16, 1998 (hereinafter, Michelsen; copy enclosed).

The issue on appeal may be stated as follows:

Whether claims 1 to 9 are unpatentable under 35 U.S.C. Section 112, first paragraph, as failing to comply with the written description requirement as set forth in the rejection.

Whether claims 1, 2, 4, and 5 are unpatentable under 35 U.S.C. Section 102(b) as anticipated by Brandt et al.

Whether claims 3 and 6 to 9 are unpatentable under 35 U.S.C. Section 103(a) over Brandt et al in view of Michelsen.

VII. GROUPING OF CLAIMS

The claims stand or fall together.

VIII. ARGUMENT

ARGUMENT RELATING TO THE REJECTION OF CLAIMS 1 TO 9 UNDER 35 U.S.C. 112, FIRST PARAGRAPH

Claims 1 to 9 have been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. It is asserted "The claim(s) contains subject matter which was not described in the specification in such as way as to reasonably convey to

one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites a 'single blanket of resilient fibrous insulation having no folds therein.' However, there is no support for a single blanket of resilient fibrous insulation having no folds therein in the specification. Negative limitations are not allowed in the claim unless expressly set forth in the specification. Ex parte Grasselli, 231 USPQ 393. The specification does not indicate that the fibrous layer cannot have folds."

The specification (lines 16 to 21 of page 2 and lines 5 to 18 of page 6) and Figures 5 and 6 of the drawings of the subject patent application both convey to one skilled in the art that each of the series 50 of individual blanket sections, which are cut from the resilient fibrous insulation blanket 46 as shown in Figure 5, forms a separate resilient fibrous insulation batt 20 of the subject invention that is not folded. On page 6, lines 3 to 7, it is clearly stated "Figure 5 schematically shows a series 50 of blanket sections that have been cut longitudinally in the cutting station 28 to widths equal to the thickness of the resilient fibrous insulation batts 20 and transversely in the cutting station 30 to lengths equal to the lengths of the resilient fibrous insulation batts 20 to form a plurality of resilient fibrous insulation batts 20, such as the insulation batt 20 of FIG. 6." The insulation blanket 46 from which each of the series 50 of blanket sections is cut to form the individual insulation batts 20 has a thickness equal to or substantially equal to the width of each of the insulation batts 20 formed by cutting the insulation blanket 46 into sections, each of the blanket sections of the series 50 of blanket sections cut from the insulation blanket 46 to form each of the insulation batts 20 has a width equal to the thickness of the insulation batts 20 being formed by cutting the insulation blanket 46 into sections, and each of the blanket sections of the series 50 of blanket sections cut from the insulation blanket 46 to form each of the insulation batts 20 has a length equal to the length

of the insulation batts 20 being formed by cutting the insulation blanket 46 into sections. Thus, each of the blanket sections of the series 50 of blanket sections cut from the insulation blanket 46 to form the individual insulation batts 20 is cut to its final size and shape. If any of these blanket sections were folded after being cut to final size and shape, the resulting insulation batt and its dimensions would not be the insulation batt 20 as set forth in the specification and claims and shown in the drawings.

The fact that the resilient fibrous insulation batt 20 of the subject invention is cut to its final size and shape without folding the batt is emphasized in the SUMMARY OF THE INVENTION. In the SUMMARY OF THE INVENTION on page 2, lines 16 to 21, it states, "in the process or method of the present invention, a blanket is formed having a thickness equal to the width of the batts to be formed from the blanket. The blanket is then cut longitudinally and transversely, in directions perpendicular to the major surfaces of the blanket, into sections having thicknesses and lengths equal to those of the batts to complete the formation of the batts". Thus, as stated in the SUMMARY OF THE INVENTION, the formation of the batts 20 is completed when the blanket is cut and there is no folding of the blanket sections to form the batts 20 of the subject invention.

While, as discussed above, there is a literal basis in the specification for the negative limitation of claim 1, the MPEP further states: "Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support. Ex parte Parks, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993)." Since, as pointed out above, the specification clearly supports the negative limitation in claim 1 and depending claims 2 to 9 and the drawings further support the negative limitation in claim 1 and depending claims 2 to 9, the withdrawal of the rejection of claim 1 for failing to comply with 35 U.S.C. 112, first paragraph, is solicited.

ARGUMENT RELATING TO THE REJECTION

OF CLAIMS 1, 2, 4, AND 5 UNDER 35 U.S.C. 102(b)

AS BEING ANTICIPATED BY BRANDT ET AL (WO 94/16162)

Claims 1, 2, 4, and 5 have been rejected under 35 U.S.C. 102(b) as being anticipated by Brandt et al (WO 94/16162).

As discussed in the section of this brief entitled "Summary of the Invention", the resilient fibrous insulation batt 20 of the subject invention consists essentially of a single blanket section cut from the resilient fibrous insulation blanket 46 and has no folds therein. The insulation batt 20 has first and second major surfaces 62 that, with respect to each other, lie in substantially parallel planes and that each extend the length and width of the insulation batt 20. The insulation batt 20 has first and second lateral surfaces 64 that, with respect to each other, lie in substantially parallel planes, that extend for the length of the batt 20, and that extend between the major surfaces 62 of the batt 20. The insulation batt 20 has first and second end surfaces 66 that, with respect to each other, lie in substantially parallel planes, that extend the width of the batt 20, and that extend between the major surfaces 62 of the batt 20. The fibers of the insulation batt 20 are randomly oriented and entangled together and predominately lie in planes 70 that extend substantially perpendicular to the planes of the major surfaces 62 and the end surfaces 66 of the batt 20 and substantially parallel to the planes of the lateral surfaces 64 of the batt 20 to facilitate a widthwise compression of the insulation batt 20.

Prior art insulation batts such as insulation batts 120 (shown in Figures 7 and 8 and described in lines 18 to 30 of page 6 of the specification) having randomly oriented fibers lying in planes 122 that are substantially parallel to the major surfaces 124 of the batts and

substantially perpendicular to the lateral surfaces 126 and end surfaces 128 of the batts are harder to compress widthwise than the resilient insulation batts 20 of the subject invention. The resilient insulation batts 20 of the subject invention have the randomly oriented fibers of the batts oriented differently from the prior art batts so that the randomly oriented fibers lie in planes that extend substantially perpendicular to the planes of the major surfaces and the end surfaces of the batts and substantially parallel to the planes of the lateral surfaces of the batt to facilitate a widthwise compression of the insulation batts 20. By being more easily compressible in a widthwise direction than the prior art batts 120, the batts 20 of the subject invention can be more easily fitted into wall cavities or other cavities to be insulated that are less in width than the width of the insulation batts.

Brandt et al disclose a mineral fiber-insulating web made from a first mineral fiber web wherein the fibers of the first mineral fiber web, rather than being randomly oriented fibers extending in planes like the fibers of the insulation batt of subject invention, are fibers arranged in the generally longitudinal direction of the first mineral fiber web. This first mineral fiber web is moved in the longitudinal direction of the web and folded transversely relative to the longitudinal direction and parallel to the transverse direction of the first mineral fiber web, so as to produce a second mineral fiber web containing mineral fibers that still extend generally in the same direction with respect to each other rather than being randomly oriented like those of the insulation batt of the subject invention but which are now arranged in planes that extend generally perpendicular to the major surfaces and lateral surfaces of the second mineral fiber web and generally parallel to the end surfaces of the second mineral fiber web. Whether the second mineral fiber web of Brandt et al is uncut as shown in Figures 7 and 9 of Brandt et al or cut and rejoined as shown in Figures 8 and 10 of Brandt et al, the fibers of the second mineral fiber web retain the generally parallel orientation with respect to each other that the fibers had

when the fibers formed the first mineral fiber web where the fibers were arranged in the generally longitudinal direction of the first mineral fiber web. With this fiber orientation rather than the random fiber orientation of the fibers in the insulation batt 20 of the subject invention, it may be acceptable to have the fibers of the Brandt et al second mineral fiber web lying in planes that extend generally perpendicular to the major surfaces and lateral surfaces of the second mineral fiber web and generally parallel to the end surfaces of the second mineral fiber web. However, the randomly oriented fibers of the insulation batt 20 of the subject invention must lie in planes that are substantially perpendicular to the planes of the major surfaces and the end surfaces of the blanket and substantially parallel to the planes of the lateral surfaces of the blanket to facilitate a widthwise compression of the insulation batt 20. Since Brandt et al, with or without folds, neither discloses nor suggests a resilient fibrous insulation batt with a structure such as that set forth in claim 1, claim 1 and the claims depending therefrom (claims 2 to 9) are patentable over Brandt et al.

ARGUMENT RELATING TO THE REJECTION OF CLAIMS 3 AND 6 TO 9 UNDER 35 U.S.C. 103(a) AS BEING UNPATENTABLE OVER BRANDT ET AL. IN VIEW OF MICHELSEN

Claims 3 and 6 to 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Brandt et al. in view of Michelsen.

While, Michelsen discloses that a fibrous nonwoven insulation may be made from glass fibers and polymeric fibers and that the fibers of the insulation may be held together by entanglement, Michelsen does not otherwise supplement the disclosure of Brandt et al. Accordingly, claims 3 and 6 to 9 are patentable for the same reasons discussed above in

connection with the rejection of claims 1, 2, 4 and 5.

In view of the arguments presented by Appellants with respect to the patentability of claims 1 to 9, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the rejection of and allow claims 1 to 9.

Respectfully submitted,

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APPENDIX

CLAIMS ON APPEAL

1. A resilient fibrous insulation batt consisting essentially of:

a single blanket of resilient fibrous insulation having no folds therein; the blanket having a length, a width and a thickness; the length of the blanket being a longest dimension of the blanket; the thickness of the blanket being a shortest dimension of the blanket; the width of the blanket being a dimension of the blanket intermediate the length and the thickness of the blanket in magnitude; the blanket having first and second major surfaces that, with respect to each other, lie in substantially parallel planes and that each extend the length and width of the blanket; the blanket having first and second lateral surfaces that, with respect to each other, lie in substantially parallel planes, that extend for the length of the blanket, and that extend between the major surfaces of the blanket; the blanket having first and second end surfaces that, with respect to each other, lie in substantially parallel planes, that extend the width of the blanket, and that extend between the major surfaces of the blanket; the fibers of the blanket being randomly oriented and entangled together and predominately lying in planes that extend substantially perpendicular to the planes of the major surfaces and the end surfaces of the blanket and substantially parallel to the planes of the lateral surfaces of the blanket to facilitate a widthwise compression of the blanket.

2. The resilient fibrous insulation batt according to claim 1, wherein:

the fibers are glass fibers.

3. The resilient fibrous insulation batt according to claim 1, wherein: the fibers are polymeric fibers.

4. The resilient fibrous insulation batt according to claim 1, wherein: a binder bonds the fibers together at points of intersection.

5. The resilient fibrous insulation batt according to claim 4, wherein: the fibers are glass fibers.

6. The resilient fibrous insulation batt according to claim 4, wherein: the fibers are polymeric fibers.

7. The resilient fibrous insulation batt according to claim 1, wherein: the blanket is binderless.

8. The resilient fibrous insulation batt according to claim 7, wherein: the fibers are glass fibers.

9. The resilient fibrous insulation batt according to claim 7, wherein: the fibers are polymeric fibers.

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Case Docket No. 7150
Date: April 6, 2005

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Re: Application of: Bogrett et al
Serial No.: 09/912,290
Filed: July 24, 2001
For: INSULATION BATT AND METHOD OF MAKING THE BATT

Art Unit: 1771
Examiner: Jeremy R. Pierce

Sir:

Transmitted herewith is/are the following document(s) related to the above-identified application:

[ ] Notice of Appeal

[ ] Associate Power of Attorney

[X] Brief on Appeal (in triplicate)

[ ] Request for Oral Hearing

Please extend the time for filing the Notice of Appeal _____ ( ) month(s) to _____.

The fee has been calculated as shown below:

Notice of Appeal	$500.00	
Appeal Brief	$500.00	500.00
Request for Oral Hearing	$1000.00	
Fee for Extension of Time		
1 month $120.00, 2 months $450.00, 3 months $1020.00		500.00
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[X] Charge $500.00 to Deposit Account No. 10-0625.

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[X] Two additional copies of this sheet are enclosed.

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